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Paper No. 25

In re Application of
BRANDHORST ET AL.
Application No.: 09/368,505
Filed: August 05, 1999

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: **DECISION ON PETITION**
: **UNDER 37CFR1.181**
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This is a decision on petitioner's request filed under 37CFR 1.181 on July 16, 2002 to exercise supervisory review over certain actions of the Primary Examiner in the Office Action mailed July 5, 2002. In particular, petitioner requests that the Office Action of July 5, 2002 be withdrawn and the Examiner be ordered to write an Examiner's Answer to the Brief on Appeal, filed April 10, 2002.

A review of the file wrapper shows that on November 30, 2001, the examiner issued a Rejection of claims 6-38 and that this rejection was the second rejection of these claims by the examiner. On February 20, 2002, applicant filed an amendment amending 18 of the rejected claims. On March 12, 2002, applicant filed a Notice of Appeal to the rejection of claims 6-38. (Appeal of claims "twice rejected" is provided for under 37 CFR 1.191(a). Here, the claims as present at the time of the November 30, 2001 rejection remained un-amended from the previous Office Action and hence, were twice rejected.) In the subsequent action dated July 5, 2002, the Examiner stated the Notice of Appeal and Appeal Brief were "improper since the amendment filed on 4/20/02 has not yet been examined and the claims that were presented in the amendment have not yet been rejected." The Examiner rejected claims 6-38, as amended on February 20, 2002, and made the Office Action final.

The Petitioner states pursuant to 37 CFR 1.191(a) Applicant's election to file a Notice of Appeal was a proper course of action as the claims listed in the Notice of Appeal had been twice rejected after the November 30, 2001 Office Action. Petitioner requests Supervisory Review of the Examiner's position that the Notice of Appeal was not appropriate as filed at that stage of the prosecution and requests 1) that the Final Rejection of July 5, 2002 be withdrawn and 2) the Examiner ordered to write an Examiner's Answer to the Appeal Brief of July 16, 2002.

It is noted that the claims listed as appealed and as supported by argument in the Appeal Brief are, specifically, the claims as amended on February 20, 2002.

Petitioner has filed a "Conditional Notice of Appeal," on January 6, 2003 to the finally rejected claims of the July 5, 2002 Office Action. The Appeal fee was filed on March 12, 2002.

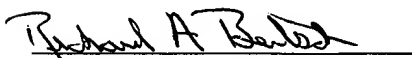
Decision: the file wrapper presented to the examiner before the Office Action of July 5, 2002, contained 18 newly amended claims, as presented by the February 20, 2002 amendment: these claims had not previously been considered by the Examiner nor previously rejected. As they were not "twice rejected," nor under Final Rejection, appealing from the decision of the examiner to the Board of Patent Appeals was not a procedural option to Applicant. Hence, the examiner's action to proceed with an Office Action that included a rejection of the claims, and not to write an Examiner's Answer, was not in error and will not be altered. The Petition under 37 CFR 1.181, as related to the examiner's actions, is DISMISSED.

Further: Petitioner has suggested several alternative courses of action in response to the Petition, all of which are essentially directed to accelerating prosecution to move the application to consideration by the Board of Patent Appeals. In fact, reinstatement of the Notice of Appeal and Appeal Brief were contemplated by the examiner in the Final Rejection. It is noted that the Fee for Notice of Appeal has previously been paid.

Resolution: The Notice of Appeal fee, previously paid, is reinstated to complete the Notice of Appeal, which is hereby reinstated. The Brief on Appeal, filed April 10, 2002, is hereby reinstated and the Appeal fee will be charged to Applicant's deposit account, as requested in the Introduction to the Brief on Appeal. Thereafter, the application will be forwarded to the Examiner for consideration of the Brief on Appeal.

Applicant should note, that an amended brief may be required that is commensurate with the reduced issues for appeal as set forth in the Office Action of July 5, 2002.

The application is being returned to the examiner for processing, as listed above, and for action not inconsistent with this Decision letter.


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